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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,028	11/21/2003	Randy D. Jester	1725 (TI-02-3)	3210
40256	7590	10/29/2004	EXAMINER NOLAN, SANDRA M	
FERRELLS, PLLC P. O. BOX 312 CLIFTON, VA 20124-1706			ART UNIT 1772	PAPER NUMBER

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/720,028	JESTER, RANDY D.
	Examiner Sandra M. Nolan	Art Unit 1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-30 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4-26-04.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claims***

1. Claims 1-30 are pending.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 26 April 2004 was considered by the examiner.

The German publications were not translated.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-7, 19-23 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06271724 A (abstract).

The Japanese abstract teaches films (title) that contain blends of ethylene/-norbornene (E/N) copolymers (fifth paragraph). The films have glass transition

temperatures of 50 °C or less (second paragraph) and seal temperatures of 85 °C (last line). They have good elastic recovery (title).

It fails to teach the specific glass transition value of applicants' claims 1 or 26-30 or the norbornene content of applicants' claim 30.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at the time of the invention to employ copolymers having suitable glass transition properties and norbornene contents in the films of the Japanese abstract in order to tailor the films properties to any desired application(s). The use of copolymers with lower glass transition temperatures would be an obvious way to lower the temperature at which the films are sealed.

The properties recited in the dependent claims and in claims 26-30 would be expected in films suggested by the Japanese abstract.

The use of conventional processes to use the films is deemed a matter of engineering choice.

6. Claims 8-24 and 26-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Miharu et al (US 5,912,070) in view of the Japanese abstract.

Miharu teaches laminates containing polyester layers (A), cyclic olefin layers (C) and adhesive layers (B) (abstract). The (A) layers contain polyethylene terephthalate (col. 4, lines 5 and 17). The (C) layers contain copolymers of ethylene (col. 10, line 21) and norbornene (col. 23, line 38) having cyclic monomer contents of 5 to 80% (col. 10, lines 24-25). Multiple (C) layers can be present (col. 17, line 38).

The Japanese abstract is discussed above.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the copolymers of the Japanese abstract, or others with similar glass transition properties, in the laminates of Miharu in order to produce laminates having good elastic recovery.

The motivation to employ the copolymers of the Japanese abstract, or others with similar glass transition properties, in the laminates of Miharu is found in the title of the abstract, where good elastic memory is taught.

It is deemed desirable to make sealable laminated films having good elastic memory, so that they can be used in effective packaging.

The properties recited in the dependent claims and in claims 26-30 would be expected in films suggested by the combined references.

The use of conventional processes to use the films is deemed a matter of engineering choice.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beer (EP 849074 A2, abstract).

Beer teaches sealable E/N packaging films that are sealed at temperatures of 5 to 70 above their glass transition temperatures (first paragraph).

It fails to teach bonding the films to themselves.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the films of Beers in self-bonding applications.

The motivation to employ the films of Beer as self-bonding films is found in the first paragraph of the abstract, where sealing temperatures of 5 to 70 degrees over the glass transition temperatures are taught.

Since packaging involves sealing film layers to themselves to form seams and/or overlapped sealed areas, the use of the Beer films would involve the bonding of films with useful glass transition temperatures to themselves.

The selection of films having useful glass transition temperatures is deemed a matter of engineering choice, depending upon the properties desired in the packaging.

### ***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

*S. M. Nolan*  
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Primary Examiner  
Technology Center 1700

10720028(20041028)